PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Andrew E. Fano et al.	
Serial No.:	09/520,943	
Filing Date:	March 8, 2000	**Group Art Unit:** 3623
Title:	MAKING FINANCIAL DECISIONS BY BALANCING GOALS IN A FINANCIAL MANAGER	**Examiner:** Beth Van Doren
Docket No:	60021-352501	

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

APPELLANT'S APPEAL BRIEF

Dear Sir:

In response to the Office communication dated January 13, 2005, Appellant appeals the rejections of Examiner Beth Van Doren.

(1)   <u>REAL PARTY IN INTEREST</u>

The present application was originally assigned to Andersen Consulting LLP, which subsequently changed its name to Accenture LLP.

(2)   <u>RELATED APPEALS AND INTERFERENCES</u>

There are no appeals or interferences related to the present case.

(3)   STATUS OF CLAIMS

Claims 21-39, 41-45, 47-68, 70-74, 76-97, 99-103, and 105-107 are pending and are herein appealed. Claims 1-20, 40, 46, 69, 75, 98, 104, and 108-122 are cancelled.

Claims 21-27, 50-56, and 79-85 have been rejected under 35 U.S.C. § 102(e) as being anticipated by *Jones et al.*, U.S. Patent No. 6,021,397. Claims 28-39, 41-49, 50-68, 70-78, 86-97, and 99-107 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over *Jones et al.*, U.S. Patent No. 6,021,397.

(4)   STATUS OF AMENDMENTS

Subsequent to issuance of the Office action made final dated January 13, 2005, an Amendment dated July 11, 2005 was filed contemporaneously with this appeal brief canceling claims 40, 46, 69, 75, 98, 104, and 108-122.

(5)   SUMMARY OF CLAIMED SUBJECT MATTER

The present invention generally relates to a planning tool which allows for the modification of a plurality of user-selected goals and the result of such modification being displayed to the user. The various claims are directed toward a method, a computer program on a computer readable medium, and a system, wherein the general improvements over the prior art include, *inter alia*, modeling tradeoffs of choices made by a user among a plurality of selected goals; and providing links to identified providers that correspond to and supply offerings that facilitate attainment of the selected goals.

More specifically, Appellant's claims 21, 50, and 79 recite a method, computer system, and computer program embodied on a computer readable medium enabling users to make decisions by modeling tradeoffs between personal goals, comprising: (a) receiving information from a user including information related to a cash flow of the user (*see* Specification at p. 11, ll. 5-7; 13-19); (b) graphically presenting to the user a plurality of goals based upon the information provided from the user, wherein the plurality of goals are related to the cash flow of the user (*see* Specification at p. 11, ll. 4-5); (c) allowing the user to select at least one goal of the plurality of goals (*see* Specification at p. 11, ll. 3-11); (d) presenting to the user a plurality of the user preferences for each selected goal (*see* Specification at p. 11, ll. 3-11); (e) allowing the user

to make an adjustment to user preferences related to one of the selected goals (*see* Specification at p. 11, ll. 3-11); (f) determining an impact of the adjustment on attaining the remaining goals (*see* Specification at p. 11, ll. 3-11); and (g) graphically presenting to the user the impact of the adjustment on attaining the goals by again presenting the plurality of goals as adjusted (*see* Specification at p. 11, ll. 3-11; p. 30, ll. 1 – p. 33, ll. 18).

Claims 22, 51, and 80 recite the method, system, and computer program wherein the goals are interrelated financials goals (*see* Specification at p. 11, ll. 4-5).

Claims 23, 53, and 81 recite the method, system, and computer program wherein the goals include expenditures for at least one of a home, a vehicle, planned monthly allowance and savings, planned furniture expenses, planned appliance purchases, a vacation, children's education, and retirement home (*see* Specification at p. 11, ll. 21-26).

Claims 24, 53, and 82 recite a method, system, and computer program wherein the step of allowing the user to make an adjustment further comprises: (a) presenting to the user an adjustable priority indicia for adjusting preferences related to the selected goal, wherein the priority indicia adjusts the level of priority of achieving the selected goal as related to the other goals; (b) allowing the user to make an adjustment to the priority indicia; and (c) adjusting the level of priority of achieving the selected goal responsive to the user's adjustment of the priority indicia (*see* Specification at p. 11, ll. 28 – p. 12, ll. 2).

Claims 25, 54, and 85 recite a method, system, and computer program wherein the step of allowing the user to make an adjustment further comprises: (a) presenting to the user an adjustable time indicia for the selected goal; (b) allowing the user to make an adjustment to the time indicia; and (c) adjusting the amount of time expected for achieving the selected goal responsive to the user's adjustment of the time indicia (*see* Specification at p. 12, ll. 9-17).

Claims 26, 55, and 84 recite a method, system, and computer program wherein the step of allowing the user to make an adjustment further comprises: (a) presenting to the user an adjustable quality indicia for the selected goal; (b) allowing the user to make an adjustment to the quality indicia; and (c) adjusting the quality of the selected goal responsive to the user's adjustment of the quality indicia (*see* Specification at p. 12, ll. 9-17).

Claims 27, 56, and 85 recite a method, system, and computer program wherein the step of allowing the user to make an adjustment further comprises: (a) presenting to the user an

adjustable indicia of favoritism between time and quality for the selected goal; (b) allowing the user to make an adjustment to the favoritism indicia; and (c) adjusting the favoritism between time and quality of the selected goal responsive to the user's adjustment of the favoritism indicia (*see* Specification at p. 4, ll. 14-15).

Claims 28, 57, and 86 recite a method, system, and computer program of claims 27, 56, and 85, respectively, further comprising creating a user profile for facilitating targeted advertising based on the user information, user goals and adjustment preferences (*see* Specification at p. 4, ll. 18-20).

Claims 29, 58, and 87 reciting a method, system, and computer program of claims 28, 57, and 86 further comprising creating at least one offering targeted to the user profile for achieving the goal (*see* Specification at p. 25, ll. 15-25).

Claims 30, 59, and 88 recite a method, system, and computer program of claims 29, 58, and 87 further comprising transmitting the at least one targeted offering to the user (*see* Specification at p. 25, ll. 15-25).

Claims 31, 60, and 89 reciting a method, system, and computer program of claims 30, 59, and 88, respectively, wherein the transmission of the matched offering to the user is done using a computer network (*see* Specification at p. 25 in passim).

Claims 32, 61, and 90 reciting a method, system, and computer program of claims 31, 60, and 89, respectively, wherein the network is the internet.

Claims 33, 62, and 91 reciting a method, system, and computer program of claims 29, 58, and 87, respectively, further comprising using the user profile information as market intelligence (*see* Specification at p. 27, ll. 21-29).

Claims 34, 63, and 92 reciting a method, system, and computer program of claims 29, 58, and 87, respectively, wherein the targeted offering is a financial instrument (*see* Specification at p. 26, ll. 2-7).

Claims 35, 64, and 93 reciting a method, system, and computer program of claims 29, 58, and 87, respectively, further comprising notifying at least one provider of the suggested targeted offering when the user changes a preference related to attaining one or more of the goals (*see* Specification at p. 26, ll. 2-7).

Claims 36, 65, and 94 reciting a method, system, and computer program of claims 29, 58, and 87, respectively, wherein the offering includes at least one of a product and a service (*see* Specification at p. 26, ll. 2-7).

Claims 37, 66, and 95 reciting a method, system, and computer program of claims 28, 57, and 86, respectively, wherein the goals include at least one of a home, a vehicle, planned monthly allowance and savings, planned furniture expenses, planned appliance purchases, a vacation, children's education, and retirement home (*see* Specification at p. 29, ll. 9-12).

Claims 38, 67, and 96 reciting a method, system, and computer program of claims 30, 59, and 88, respectively, wherein the matched offering includes banner advertising displayed to the user, whereby the banner advertising content displayed is derived from the proposed goals designated by the user (*see* Specification at p. 25, ll. 15-25).

Claims 39, 68, and 97 reciting a method, system, and computer program of claims 29, 58, and 87, respectively, further comprising storing the targeted offering in a database (*see* Specification at p. 27, ll. 1-2).

Claims 41, 70, and 99 reciting the method, system, and computer program of claims 21, 50, and 79, respectively, wherein each of the goals has a range of options, which can be further selected by the user, the method further comprising: (a) displaying at least one provider for providing an option corresponding to a selected goal, (b) allowing a user to select a preferred provider; (c) allowing the user to select at least one option provided by the selected provider; and (d) allowing the user to add the selected option to the range of options for the goal (*see* Specification at p. 36, l. 5 – p. 37, l. 7).

Claims 42, 71, and 100 reciting the method, system, and computer program of claims 41, 70, and 99, respectively, wherein each option has a range of features, further comprising: (a) displaying the range of options for a goal; (b) allowing the user to select one of the options based on the adjusted preference; (c) displaying at least one provider for providing an option corresponding to a selected goal; (d) allowing the user to select the provider; (e) allowing the user to select at least one option provided by the selected provider; (f) allowing the user to select at least one feature provided by the selected provider for the selected option; and (g) allowing the user to add the selected feature to the range of features corresponding to the selected option (*see* Specification at p. 36, l. 5 – p. 37, l. 7).

Claims 43, 72, and 101 reciting a method, system, and computer program of claims 41, 70, and 99, respectively, wherein a list containing a plurality of providers is displayed and the selected provider is selected from the list of providers (*see* Specification at p. 36, l. 6 – p. 37, l. 7).

Claims 44, 73, and 102 reciting a method, systems, and computer program of claims 41, 70, and 99, respectively, wherein the at least one option includes a plurality of features, the method further comprising: (a) presenting to the user the plurality of features; (b) allowing the user to select at least one of the plurality of features for the selected option (*see* Specification at p. 36, l. 6 – p. 37, l. 7).

Claims 45, 74, and 103 reciting a method, system, and computer program of claims 41, 70, and 99, respectively, further comprising utilizing a network to display information relating to the provider (*see* Specification at p. 36, l. 6 – p. 37, l. 7).

Claims 47, 76, and 105 recite a method, system, and computer program of claims 41, 70, and 99, respectively, further comprising: (a) presenting to the user at least one insurance provider; (b) allowing the user to select an insurance provider whose product can be employed to attain the goal (*see* Specification at p. 38, ll. 1-8)

Claims 48, 77, and 106 recite a method, system, and computer program of claims 41, 70, and 99, respectively, further comprising displaying features of the selected option (*see* Specification at p. 37, l. 24 – p. 38, l. 8).

Claims 49, 78, and 107 recite a method, system, and computer program of claims 41, 70, and 99, respectively, further comprising: (a) presenting to the user an indicia of desireability for the selected option; and (b) allowing the user to adjust the desireability for the selected option to reflect the user's desire for obtaining the selected option by adjusting (*see* Specification at p. 38, ll. 10-14).

(6) GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The Examiner rejected claims 21-27, 50-56, and 79-85 under 35 U.S.C. § 102(e) as being unpatentable over *Jones et al.*, U.S. Patent No. 6,021,397. In making this anticipation rejection, has the Examiner established that all elements of the claims are explicitly or inherently disclosed in *Jones*?

The Examiner rejected claims 28-49, 57-78, and 86-107 under 35 U.S.C. § 103(a) as being unpatentable over *Jones et al.*, U.S. Patent No. 6,021,397. In making this obviousness rejection, has the Examiner established a *prima facie* case of obviousness?

(7)   ARGUMENT

A.   *Background*

Appellant filed the original application on March 8, 2000. The first substantive Office action addressing the merits of patentability was mailed March 11, 2003, wherein Examiner Van Doren rejected then pending claims 1-20 pursuant to 35 U.S.C. §§ 101; 102(e); 103(a); and 112 ¶ 2.

On July 11, 2003, Appellant responded to the Office action, amending the specification, amending the drawings, and amending the claims by canceling claims 1-20 and adding method claims 21-49. Appellant additionally presented detailed arguments regarding the differences between the invention and the cited references.

On November 18, 2003, Examiner Van Doren issued an Office action made final rejecting claims 21-49 pursuant to 35 U.S.C. § 102(e) on the same cited prior art, and § 112 ¶ 2.[1]

On February 18, 2004, Appellant filed an Amendment After Final and amended the claims to overcome the rejections. Appellant additionally presented detailed arguments regarding the differences between the invention and the cited references.

On March 12, 2004, Examiner Van Doren issued an Advisory Action, noting the arguments and amendment fail to place the claims in condition for allowance, but would be entered for purposes of Appeal.

On April 19, 2004, Appellant filed a Request for Continued Examination, and requested consideration of the Amendment previously filed on February 18, 2004, as well as made a request for a two-month extension of time.

On May 4, 2004, Appellant filed a Preliminary Amendment in which Appellant amended claims 21-49 and added system claims 50-78 and apparatus claims 79-107. Appellant

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[1]   The Office action dated November 18, 2003 responded to an Amendment filed September 11, 2003, which corrected alleged deficiencies of the Amendment filed July 11, 2003, as noted in the Notice of Non-Compliant Amendment mailed August 1, 2003.

additionally presented detailed arguments regarding the differences between the invention and the cited references.

On July 19 2004, Examiner Van Doren issued an Office action rejecting claims 21-27, 37, 50-56, 66, and 79-85 and 95 pursuant to 35 U.S.C. § 102(e) over the same cited prior art; and 28-36, 38-49, 57-65, 67-78, 86-94, and 96-107, and 86 pursuant to 35 U.S.C. § 103(a) over the same cited prior art.

On November 19, 2004, Appellant filed an Amendment and Response, amended the claims, and additionally added claims 108-122. Appellant additionally presented detailed arguments regarding the differences between the invention and the cited references.

On January 13, 2005, Examiner Van Doren issued an Office action made final rejecting claims 21-27, 50-56, 79-85, and 108-113 pursuant to 35 U.S.C. § 102(e) on the same cited prior art; and 28-36, 38-49, 57-78, 86-107, and 114-122 pursuant to 35 U.S.C. § 103(a) over the same cited prior art.

In response, Appellant filed a Notice of Appeal, which was received by the Office on April 13, 2005. Each of Examiner Van Doren's rejections will be addressed below.

On or about July 11, 2005, in preparing and refining the claims for appeal, Appellant filed an Amendment canceling claims 40, 46, 69, 75, 98, 104, and 108-122.

B. *Rejection of Claims 21, 50, and 79 pursuant to 35 U.S.C. § 102*

Claims 21-27, 50-56, and 79-85 have been rejected pursuant to 35 U.S.C. § 102(e) as being anticipated by *Jones et al.*, U.S. Patent No. 6,021,297 (hereinafter "*Jones*"). Although superficially attractive, *Jones* fails to disclose, either explicitly or inherently, all elements of the claimed invention, and thus does not function as anticipatory prior art. Appellant respectfully requests that Examiner's rejections pursuant to 35 U.S.C. § 102(e) be reversed and a Statement of Allowability be issued.

The present invention generally provides a user the ability to model tradeoffs between a plurality of disparate personal goals, comprising:

(a)   receiving information from a user including information related to a cash flow of the user;

(b)   graphically presenting the user a plurality of goals based upon the information provided by the user, wherein the plurality of goals are related to the cash flow of the user;

(c)   allowing the user to select at least one goal of the plurality of goals;

(d)   presenting to the user a plurality of the user preferences for each selected goal;

(e)   allowing the user to make an adjustment to user preferences related to one of the selected goals;

(f)   determining an impact of the adjustment on attaining the remaining goals; and

(g)   graphically presenting to the user the impact of the adjustment on attaining the goals by again presenting the plurality of goals as adjusted.

See Appendix, claims 21 (method), 50 (system), and 79 (computer program embodied on a computer-readable medium).

A Statement of Allowability should be issued because *Jones* fails to anticipate the claimed invention. "A claim is anticipated *only* if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." MPEP § 2131.01 (quoting *Verdegaal Bros. v. Union Oil of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987)) (emphasis added). It is the "identical invention" that must be exhibited in the prior art for it to anticipate the claimed invention. *Id.* (quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989)). An element of a claim is inherently described in a prior art reference only "if it is the natural result flowing from the explicit disclosure of the prior art." *Schering Corp. v. Geneva Pharmaceuticals, Inc.*, 339 F.3d 1373, 1379 (Fed. Cir. 2003). In the present instance, *Jones* fails to expressly or inherently anticipate the claimed invention.

Specifically, the distinct limitations that distinguish the invention as claimed from *Jones* are: (1) presenting to the user a plurality of goals that are not necessarily financially related; and (2) graphically presenting to the user the impact of the adjustment on attaining the goals by again presenting the plurality of goals as adjusted.[2]

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[2]   Implicit or inherent disclosure may be considered summarily based upon the Office Action language, in which the Examiner does not claim any element of any rejected claim pursuant to 35 U.S.C. § 102(e) is present inherently. *See* Office Action dated January 11, 2005. Even

1. Jones fails to contemplate the impact of a plurality of goals on the same level across descriptive criteria.

The present invention is patentable because *Jones* fails to present a plurality of goals which may be modeled together and to graphically present the potential attainment for all goals. *Jones* contemplates the modeling of only a single goal, clearly financial in nature, and provides options that may be selected to project attainment of that one financial goal. *See Jones* at Abstract (explain purpose of invention is to provide optimized portfolio allocations); col. 2, ll. 58-64 (same); col. 3, ll. 40-46 (purpose is to provide guidance to select an optimized portfolio); col. 5, l. 52-col. 6, l. 34 (describing set-up and iterative process in which financial goals are considered as subset to achieving financial portfolio optimization). Moreover, *Jones* contemplates that all possible attainable goals are financially related. *See Jones* at col. 4, ll. 28-33. *Jones,* however, fails to disclose the modeling of a plurality of goals at the same time, and, moreover fails to contemplate the effect of non-financial goals on the overall model.

Quite distinguishable from *Jones*, the present invention contemplates not only the modeling of a plurality of goals simultaneously, but also contemplates the consideration of goals beyond those that are financial, amounting to a more holistic approach to planning. *See, e.g.,* claim 21(b) (contemplating "goals" in general, which read expansively includes those other than financial goals).[3] Additionally, the plurality of goals are all projected together upon a user's modification of goal options. *See, e.g.,* claim 21(g). Hence, the present invention provides a method, system, and computer program on a computer-readable medium to model the possible

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if inherency is claimed, the Examiner has failed to provide any rationale or evidence to demonstrate inherency. *See* MPEP § 2112 part IV ("In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic *necessarily* flows from the teachings of the applied prior art.") (emphasis in original). Thus, even if inherency is subsequently claimed, such argument is effectively foreclosed because such required reasoning or evidence is wholly absent.

[3] Indeed, contrary to the Examiner's anticipated position that all goals are in some way financial, publicly available literature distinguishes between financial and nonfinancial goals despite the fact that such nonfinancial goals may have an impact on financial goals if attained or pursued. *See, e.g.,* "Chapter 1, Should You Become and Entrepreneur?", *available at* <http://www.swlearning.com/swepstuff/previews/files/generalbusiness/053843600X/entre_c h01.pdf> (as of July 6, 2005). Hence, it is inaccurate to claim all goals are financial.

realization of multiple goals that are not necessarily financial in nature. In contrast, *Jones* contemplates only the modeling of a financial goal which also includes the consideration of several financial goals. *Jones,* col. 4, ll. 28-33.

It is anticipated that the Examiner will argue that *Jones* explicitly discloses modeling several goals simultaneously, referencing language at column 6, lines 35-39 and 50-59. While facially appealing, thorough consideration of this language finds that use of "goals" in the plural and discussion of attaining multiple financial "goals" can only be interpreted with the balance of the specification to mean attainment is considered in the context of a single goal; mapping multiple financial goals requires multiple iterations. *See Jones, e.g.,* col. 13, l. 44-col. 18, l. 49 (discussing equations used to produce optimized portfolio in terms of attaining a single goal). Moreover, these multiple financial goals are considered as factors affecting attainment of the overall "optimum financial portfolio," the goal for which *Jones* is oriented. *See Jones, e.g.,* col. 5, ll. 52-61. Clear, however, is the inability of the *Jones* invention to project equally the attainment of financial *and* non-financial goals; thus, *Jones* does not anticipate the present invention. The present invention contemplates an expansive method, system, and computer program to model projected goal attainment for multiple goals, a holistic approach to life planning. Thus, rejection based upon 35 U.S.C. § 102(e) is inappropriate, and Appellant respectfully requests that the rejection be reversed and a statement of allowability be issued.

2.   Jones fails to teach the graphical presentation of goals after adjustment.

The present invention is patentable on the additional ground that *Jones* does not expressly disclose "the graphical display of the impact of the adjustment on the goals by again presenting the plurality of goals adjusted." The Examiner cites a series of passages from *Jones* in support of rejecting element (g) of the claimed invention. However, these citations fail to provide the support as the Examiner purports.

At column 2, lines 48-64, the Summary of the *Jones* invention is recited, in which it discloses the presentation, selection, and adjustment of options to produce an optimized financial portfolio, the financial goal to which *Jones* is oriented. While interactive steps to produce different results are allegedly disclosed, not apparent or disclosed is the display of the result of these option selections on the goal selected in a graphical format.

At column 3, lines 40-67, also cited by the Examiner as disclosing the graphical presentation, the text discusses modeling the projected return with a plurality of asset classes, and provides high level description of the separate modeling equations that work together to produce the projected return. Wholly absent is any discussion of a graphical presentation of the adjustment of options on a plurality of goals; the text at issue merely discusses the interaction among several parts of the disclosed software.

At column 5, lines 50-67, the text again fails to disclose the claimed limitation. In this passage, the text discusses the initial input and configuration of data, but fails to include any discussion regarding the graphical display of the effect on all goals from the adjustment of options.

At column 6, lines 3-40 and 50-58, the text discusses the iterive process of a user trying different combinations of selected options, resulting in different iterations to determine the optimal portfolio for the user. Additionally, the text discusses the capability of ongoing monitoring to achieve such financial goals. Again, as is clear from the other citations, discussion of a graphical presentation of the result is wholly absent.

Finally, at column 7, lines 63-67, through column 8, lines 1-20, the text provides the general discussion of separate modules that operate to produce the financial projection. Discussion regarding the graphical display of a plurality of goals is entirely lacking. Hence, Appellant's invention is patentable because the limitation regarding graphical presentation is not present in *Jones*. To anticipate a claim, the prior art must disclose all elements of the claim. MPEP § 2131. Because all elements are not disclosed, Appellant respectfully requests reversal of the Examiner's rejection, and issuance of a notice of allowability.

C. *Rejection of Claims 24, 26-27, 53, 55-56, 82, and 84-85 Pursuant to 35 U.S.C.*
§ 102(e)

Rejected claims 24, 26-27, 53, 55-56, 82, and 84-85 are allowable on grounds additional to those explained in section B *supra*. Claims 24, and 26-27[4] disclose the method of claim 21 further allowing for the presentation and adjustment of various preference criteria that, if adjusted, affect the outcome of the graphical presentation of the plurality of selected goals.

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[4] Claims 24, 26, and 27 are discussed as exemplary of related claims 53, 55, 56, 82, 84, and 85.

Specifically, claims 24, 26, and 27 disclose permitting the adjustment of three separate preference criteria, priority, quality, and favoritism, which when adjusted ultimately affects the projected attainment of each goal. Notably, *Jones* fails to disclose the adjustment of such different preferences that affect the projection of attaining each of a plurality of goals; *Jones* disclosure, on which the Examiner relies, arguably and solely contemplates and discloses the adjustment of the time by which a goal would be attained. *See Jones* at col. 6, ll. 3-35 (in determining goal projection, program suggesting change of time in determining feasibility of goal attainment).[5] Jones does not address the ability to select preferences, amounting to more than just cost, that balance the attainment of a selected plurality of goals against each other. Clearly, the plain language of *Jones* on which the Examiner relies is inapposite to explicitly disclosing the invention disclosed in claims 24, 26, and 27, and, thus, it is inappropriate to rejection such claims pursuant to 35 U.S.C. § 102(e).

> D.   *Rejection of Claims based on 35 U.S.C. § 103(a).*

In addition to relying on 35 U.S.C. § 102(e) as a basis for rejection, the Examiner also applied 35 U.S.C. § 103(a) as authority for rejecting several dependent claims. Specifically, claims 28-49, 57-58, and 86-107 have been rejected all in light of *Jones*, U.S. Patent No. 6,021,397 (hereinafter "*Jones*"). Fundamental to a finding of obviousness is that the prior art, in this case in combination with what is old and well-known in the art because no prior art has otherwise been cited, must teach or suggest all claim limitations of the claimed invention. *See* MPEP § 2142 (citing *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991) ("[T]he prior art reference (or references when combined) must teach or suggest all the claim limitations."). The rejections based on *Jones* are unsupported by the prior art, and a *prima facie* case of obviousness has not been established. Appellant respectfully requests that Examiner's rejections pursuant to 35 U.S.C. § 103(a) be withdrawn and a Statement of Allowability be issued.

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[5]   The Examiner also relies on language at column 4, lines 5-35 as support that *Jones* discloses, and thus anticipates, the provision, selection, and adjustment of preference criteria. However, the language at that citation does not address the adjustment of preferences or other values.

1. Claims 28-39, 41-45, 47-49, 57-61, 63-68, 70-74, 76-78, 86-90, 99-103, and 105-107.

Based upon the Office Action made final dated January 13, 2005, the Examiner in rejecting claims 28-49, 57-78, and 86-107 apparently relies upon the anticipation rejection pursuant to 35 U.S.C. § 102, and in the 35 U.S.C. § 103(a) rejections only addresses the additional claim element described in each claim. *See, e.g.,* Office Action dated 01/13/2005 at 9 at *et seq.* The Examiner provides no additional reasoning regarding how claims 21, 50, and 79 are taught or suggested by the prior art. Hence, because *Jones* fails to anticipate claims 21, 50, and 79, all claims subsequently rejected pursuant to 35 U.S.C. § 103(a) would be allowable because all elements would not be taught or disclosed in the prior art. *See* MPEP § 2143.03 (citing *In re Royka,* 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974)). Because claims 21, 50, and 79 are not anticipated, claims 28-39, 41-45, 47-49, 57-61, 63-68, 0-74, 76-78, 86-90, 99-103, and 105-107 are allowable and Appellant respectfully requests that a Notice of Allowability be issued. *See* MPEP § 2143.03 (citing *In re Fine,* 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988)).

2. Claims 33, 62, and 91.

Moreover, dependent claims 33, 62, and 91 are allowable for additional reasons. Claim 33 is nonobvious because the plain language of the claim is not addressed, and the citations on which the rejection is based are inapposite. The words of a claim must be given their plain meaning unless a specific definition is disclosed. *See* MPEP § 2111.01. Claims 33, 62, and 91 depend from their respective independent claims, and state additionally in part "using the user profile information *as* market intelligence." Claim 33, *see also* claims 62 and 91 (emphasis added). The word "as" is defined "to the same extent or degree; equally." *See* http//dictionary.reference.com/search?q=as. Hence, the plain meaning of the claim is that the user profile is equated to market intelligence. However, the Examiner in making the rejection applied an incorrect meaning to the word "as," instead interpreting the word as "with." Consideration of the citations allegedly supporting the Examiner's rejection demonstrate an interpretation of "as" in the same context as "with." *See* Figure 6; Figure 7; col. 5, ll. 50-65; col. 6, ll. 7-13, 20-37, and 60-65; col. 7, ll. 5-10; col. 10, ll. 54-67; col. 13, ll. 44-50; col. 16, ll. 10-25 (all demonstrating using the market profile "with" market research). Clearly, however, such an

interpretation fails to consider the individual meaning of "as." The citations present fail to show use of a user profile as market intelligence used by a separate entity from the user. The Examiner provides no other reasoning, nor provides any other citation to *Jones*, to support the claim that the user profile is used *as* market intelligence instead of being used *with* market intelligence, and is not taught or disclosed by *Jones*. The rejection of claims 33, 62, and 91 should be withdrawn.

As demonstrated, the Examiner has failed to establish a *prima facie* case of obviousness for the claims at issue, *and* the rejections pursuant to 35 U.S.C. § 103(a) are improper, and should be withdrawn. Appellant respectfully requests that a Statement of Allowability be issued.

(8)   CONCLUSION

Pending claims 21-27, 50-56, and 79-85 remain rejected pursuant to 35 U.S.C. § 102. Pending claims 28-39, 41-45, 47-49, 57-61, 63-68, 70-74, 76-78, 86-90, 99-103, and 105-107 remain rejected pursuant to U.S.C. § 103(a). Appellant respectfully asserts that the Examiner has not established that the cited prior art anticipates the claimed invention, nor has a *prima facie* case of obviousness been demonstrated, and requests that the Board of Patent Appeals and Interferences reverse the Examiner's decision.

Should any additional fees be necessary, the Commissioner is hereby authorized to charge or credit any such fees or overpayment to Deposit Account No. 50-1901 (Reference - 60021-352501).

Respectfully submitted,

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Attachment: Appendix (Claims Subject to Appeal)

Claims Subject to Appeal

Claims 1-20 (Canceled)

21. (Previously presented) A method for enabling users to make decisions by modeling tradeoffs between a plurality of personal goals, comprising:

    (a)   receiving information from a user including information related to a cash flow of the user;

    (b)   graphically presenting to the user a plurality of goals based upon the information provided from the user, wherein the plurality of goals are related to the cash flow of the user;

    (c)   allowing the user to select at least one goal of the plurality of goals;

    (d)   presenting to the user a plurality of the user preferences for each selected goal;

    (e)   allowing the user to make an adjustment to user preferences related to one of the selected goals;

    (f)   determining an impact of the adjustment on attaining the remaining goals; and

    (g)   graphically presenting to the user the impact of the adjustment on attaining the goals by again presenting the plurality of goals as adjusted.

22. (Previously presented) The method of claim 21 wherein the goals are interrelated financial goals.

23. (Previously presented) A method as recited in claim 22 wherein the goals include expenditures for at least one of a home, a vehicle, planned monthly allowance and savings, planned furniture expenses, planned appliance purchases, a vacation, children's education, and retirement home.

24. (Previously presented) A method as recited in claim 21 wherein the step of allowing the user to make an adjustment further comprises:

    (a)   presenting to the user an adjustable priority indicia for adjusting preferences related to the selected goal, wherein the priority indicia adjusts the level of priority of achieving the selected goal as related to other goals;

    (b)   allowing the user to make an adjustment to the priority indicia;

    (c)   adjusting the level of priority of achieving the selected goal responsive to the user's adjustment of the priority indicia.

25. (Previously presented) A method as recited in claim 21 wherein the step of allowing the user to make an adjustment further comprises:

    (a)   presenting to the user an adjustable time indicia for the selected goal;

    (b)   allowing the user to make an adjustment to the time indicia;

    (c)   adjusting the amount of time expected for achieving the selected goal responsive to the user's adjustment of the time indicia.

26. (Previously presented) A method as recited in claim 21 wherein the step of allowing the user to make an adjustment further comprises:

    (a)   presenting to the user an adjustable quality indicia for the selected goal;

    (b)   allowing the user to make an adjustment to the quality indicia;

    (c)   adjusting the quality of the selected goal responsive to the user's adjustment of the quality indicia.

27. (Previously presented) A method as recited in claim 21 wherein the step of allowing the user to make an adjustment further comprises:

    (a)   presenting to the user an adjustable indicia of favoritism between time and quality for the selected goal;

    (b)   allowing the user to make an adjustment to the favoritism indicia;

    (c)   adjusting the favoritism between time and quality of the selected goal responsive to the user's adjustment of the favoritism indicia.

28. (Previously presented) The method of claim 22 further comprising:

    creating a user profile for facilitating targeted advertising based on the user information, user goals and adjusted preferences.

29. (Previously presented) The method of claim 28 further comprising:

    creating at least one offering targeted to the user profile for achieving the goal.

30. (Previously presented) The method of claim 29 further comprising:

    transmitting the at least one targeted offering to the user.

31. (Previously presented) A method as recited in claim 30 wherein the transmission of the matched offering to the user is done using a computer network.

32. (Previously presented) A method as recited in claim 31 wherein the network is the Internet.

33. (Previously presented) The method of claim 29 further comprising :

    using the user profile information as market intelligence.

34. (Previously presented) The method of claim 29 wherein the targeted offering is a financial instrument.

35. (Previously presented) A method as recited in claim 29 further comprising:

notifying at least one provider of the suggested targeted offering when the user changes a preference related to attaining one or more of the goals.

36. (Previously presented) A method as recited in claim 29 wherein the offering includes at least one of a product and a service.

37. (Previously presented) A method as recited in claim 28 wherein the goals include at least one of a home, a vehicle, planned monthly allowance and savings, planned furniture expenses, planned appliance purchases, a vacation, children's education, and retirement home.

38. (Previously presented) A method as recited in claim 30 wherein the matched offering includes banner advertising displayed to the user, whereby the banner advertising content displayed is derived from the proposed goals designated by the user.

39. (Previously presented) A method as recited in claim 29 further comprising:

storing the targeted offering in a database.

40. (Cancelled)

41. (Previously presented) A method as recited in claim 21 wherein each of the goals has a range of options, which can be further selected by the user, the method further comprising:

(a)   displaying at least one provider for providing an option corresponding to a selected goal;

(b)   allowing the user to select a preferred provider;

(c)   allowing the user to select at least one option provided by the selected provider; and

(d)   allowing the user to add the selected option to the range of options for the goal.

42. (Previously presented) The method of claim 41 wherein each option has a range of features, further comprising:

  (a) displaying the range of options for a goal;

  (b) allowing the user to select one of the options based on the adjusted preference;

  (c) displaying at least one provider for providing an option corresponding to a selected goal;

  (d) allowing the user to select the provider;

  (e) allowing the user to select at least one option provided by the selected provider;

  (f) allowing the user to select at least one feature provided by the selected provider for the selected option; and

  (g) allowing the user to add the selected feature to the range of features corresponding to the selected option.

43. (Previously presented) A method as recited in claim 41 wherein a list containing a plurality of providers is displayed and the selected provider is selected from the list of providers.

44. (Previously presented) A method as recited in claim 41 wherein the at least one option includes a plurality of features, the method further comprising:

  (a) presenting to the user the plurality of features;

  (b) allowing the user to select at least one of the plurality of features for the selected option.

45. (Previously presented) A method as recited in claim 41 further comprising :

  utilizing a network to display information relating to the provider.

46. (Cancelled)

47. (Previously presented) A method as recited in claim 41 further comprising:

    (a)   presenting to the user at least one insurance provider;

    (b)   allowing the user to select an insurance provider whose product can be employed to attain the goal.

48. (Previously presented) A method as recited in claim 41 further comprising:

    displaying features of the selected option.

49. (Previously presented) A method as recited in claim 41 further comprising:

    (a)   presenting to the user an indicia of desirability for the selected option; and

    (b)   allowing the user to adjust the desirability for the selected option to reflect the user's desire for obtaining the selected option by adjusting the indicia of desirability.

50. (Previously presented) A computer system for enabling users to make decisions by modeling tradeoffs between personal goals, comprising:

    (a)   means for receiving information from a user including information related to a cash flow of the user;

    (b)   means for graphically presenting to the user a plurality of goals based upon the information provided from the user wherein the plurality of goals are related to the cash flow of the user;

    (c)   means for allowing the user to select at least one goal of the plurality of goals;

    (d)   means for presenting to the user a plurality of the user preferences for each selected goal;

(e) means for allowing the user to make an adjustment to user preferences related to one of the selected goals;

(f) means for determining an impact of the adjustment on attaining the remaining goals; and

(g) means for graphically presenting to the user the impact of the adjustment on attaining the goals by again presenting the plurality of goals as adjusted.

51. (Previously presented) The computer system of claim 50 wherein the goals are interrelated financial goals.

52. (Previously presented) A computer system as recited in claim 50 wherein the goals include expenditures for at least one of a home, a vehicle, planned monthly allowance and savings, planned furniture expenses, planned appliance purchases, a vacation, children's education, and retirement home.

53. (Previously presented) A computer system as recited in claim 50 further comprising:

(a) means for presenting to the user an adjustable priority indicia for adjusting preferences related to the selected goal, wherein the priority indicia adjusts the level of priority of achieving the selected goal as related to other goals;

(b) means for allowing the user to make an adjustment to the priority indicia;

(c) means for adjusting the level of priority of achieving the selected goal responsive to the user's adjustment of the priority indicia.

54. (Previously presented) A computer system as recited in claim 50 further comprising:

(a) means for presenting to the user an adjustable time indicia for the selected goal;

(b) means for allowing the user to make an adjustment to the time indicia;

(c)   means for adjusting the amount of time expected for achieving the selected goal responsive to the user's adjustment of the time indicia.

55. (Previously presented) A computer system as recited in claim 50 further comprising:

(a)   means for presenting to the user an adjustable quality indicia for the selected goal;

(b)   means for allowing the user to make an adjustment to the quality indicia;

(c)   means for adjusting the quality of the selected goal responsive to the user's adjustment of the quality indicia.

56. (Previously presented) A computer system as recited in claim 50 further comprising:

(a)   means for presenting to the user an adjustable indicia of favoritism between time and quality for the selected goal;

(b)   means for allowing the user to make an adjustment to the favoritism indicia;

(c)   means for adjusting the favoritism between time and quality of the selected goal responsive to the user's adjustment of the favoritism indicia.

57. (Previously presented) The computer system of claim 51 further comprising:

means for creating a user profile for facilitating targeted advertising based on the user information, user goals and adjusted preferences.

58. (Previously presented) The computer system of claim 57 further comprising:

means for creating at least one offering targeted to the user profile for achieving the goal.

59. (Previously presented) The computer system of claim 58 further comprising:

means for transmitting the at least one targeted offering to the user.

60. (Previously presented) The computer system as recited in claim 59 wherein the transmission of the matched offering to the user is done using a computer network.

61. (Previously presented) The computer system as recited in claim 60 wherein the network is the Internet.

62. (Previously presented) The computer system of claim 58 further comprising:

   means for using the user profile information as market intelligence.

63. (Previously presented) The computer system of claim 58 wherein the targeted offering is a financial instrument.

64. (Previously presented) A computer system as recited in claim 58 further comprising:

   means for notifying at least one provider of the suggested targeted offering when the user changes a preference related to attaining one or more of the goals.

65. (Previously presented) A computer system as recited in claim 58 wherein the offering includes at least one of a product and a service.

66. (Previously presented) A computer system as recited in claim 57 wherein the goals include at least one of a home, a vehicle, planned monthly allowance and savings, planned furniture expenses, planned appliance purchases, a vacation, children's education, and retirement home.

67. (Previously presented) A computer system as recited in claim 59 wherein the matched offering includes banner advertising displayed to the user, whereby the banner advertising content displayed is derived from the proposed goals designated by the user.

68. (Previously presented) A computer system as recited in claim 58 further comprising:

   means for storing the targeted offering in a database.

69. (Cancelled)

70. (Previously presented) A computer system as recited in claim 50 wherein each of the goals has a range of options which can be further selected by the user, the method further comprising:

(a)   means for displaying at least one provider for providing an option corresponding to a selected goal;

(b)   means for allowing the user to select a preferred provider;

(c)   means for allowing the user to select at least one option provided by the selected provider; and

(d)   means for allowing the user to add the selected option to the range of options for the goal.

71. (Previously presented) The computer system of claim 70 wherein each option has a range of features, further comprising:

(a)   means for displaying the range of options for a goal;

(b)   means for allowing the user to select one of the options based on the adjusted preference;

(c)   means for displaying at least one provider for providing an option corresponding to a selected goal;

(d)   means for allowing the user to select the provider;

(e)   means for allowing the user to select at least one option provided by the selected provider;

(f)   means for allowing the user to select at least one feature provided by the selected provider for the selected option; and

(g)   means for allowing the user to add the selected feature to the range of features corresponding to the selected option.

72. (Previously presented) A computer system as recited in claim 70 wherein a list containing a plurality of providers is displayed and the selected provider is selected from the list of providers.

73. (Previously presented) A computer system as recited in claim 70 wherein the at least one option includes a plurality of features, the method further comprising:

    (a)   means for presenting to the user the plurality of features;

    (b)   means for allowing the user to select at least one of the plurality of features for the selected option.

74. (Previously presented) A computer system as recited in claim 70 further comprising:

    means for utilizing a network to display information relating to the provider.

75. (Cancelled)

76. (Previously presented) A computer system as recited in claim 70 further comprising:

    (a)   means for presenting to the user at least one insurance provider;

    (b)   means for allowing the user to select an insurance provider whose product can be employed to attain the goal.

77. (Previously presented) A computer system as recited in claim 70 further comprising:

    means for displaying features of the selected option.

78. (Previously presented) A computer system as recited in claim 70 further comprising:

    (a)   means for presenting to the user an indicia of desirability for the selected option; and

(b)   means for allowing the user to adjust the desirability for the selected option to reflect the user's desire for obtaining the selected option by adjusting the indicia of desirability.

79. (Presently amended) A computer program embodied on a computer readable medium for enabling users to make decisions by modeling tradeoffs between personal goals, comprising:

(a)   a module for receiving information from a user including information related to a cash flow of the user;

(b)   a module for graphically presenting to the user a plurality of goals based upon the information provided from the user wherein the plurality of goals are related to the cash flow of the user;

(c)   a module for allowing the user to select at least one goal of the plurality of goals;

(d)   a module for presenting to the user a plurality of the user preferences for each selected goal;

(e)   a module for allowing the user to make an adjustment to user preferences related to one of the selected goals;

(f)   a module for determining an impact of the adjustment on attaining the remaining goals; and

(g)   a module for graphically presenting to the user the impact of the adjustment on attaining the goals by again presenting the plurality of goals as adjusted.

80. (Previously presented) The computer program of claim 79 wherein the goals are interrelated financial goals.

81. (Previously presented) A computer program as recited in claim 79 wherein the goals include expenditures for at least one of a home, a vehicle, planned monthly allowance and savings,

planned furniture expenses, planned appliance purchases, a vacation, children's education, and retirement home.

82. (Previously presented) A computer program as recited in claim 79 wherein the module for allowing the user to make an adjustment further comprises:

    (a)   a module for presenting to the user an adjustable priority indicia for adjusting preferences related to the selected goal, wherein the priority indicia adjusts the level of priority of achieving the selected goal as related to other goals;

    (b)   a module for allowing the user to make an adjustment to the priority indicia;

    (c)   a module for adjusting the level of priority of achieving the selected goal responsive to the user's adjustment of the priority indicia.

83. (Previously presented) A computer program as recited in claim 79 wherein the module for allowing the user to make an adjustment further comprises:

    (a)   a module for presenting to the user an adjustable time indicia for the selected goal;

    (b)   a module for allowing the user to make an adjustment to the time indicia;

    (c)   a module for adjusting the amount of time expected for achieving the selected goal responsive to the user's adjustment of the time indicia.

84. (Previously presented) A computer program as recited in claim 79 wherein the module for allowing the user to make an adjustment further comprises:

    (a)   a module for presenting to the user an adjustable quality indicia for the selected goal;

    (b)   a module for allowing the user to make an adjustment to the quality indicia;

(c)   a module for adjusting the quality of the selected goal responsive to the user's adjustment of the quality indicia.

85. (Previously presented) A computer program as recited in claim 79 wherein the module for allowing the user to make an adjustment further comprises:

(a)   a module for presenting to the user an adjustable indicia of favoritism between time and quality for the selected goal;

(b)   a module for allowing the user to make an adjustment to the favoritism indicia;

(c)   a module for adjusting the favoritism between time and quality of the selected goal responsive to the user's adjustment of the favoritism indicia.

86. (Previously presented) The computer program of claim 80 further comprising:

a module for creating a user profile for facilitating targeted advertising based on the user information, user goals and adjusted preferences.

87. (Previously presented) The computer program of claim 86 further comprising:

a module for creating at least one offering targeted to the user profile for achieving the goal.

88. (Previously presented) The computer program of claim 87 further comprising:

a module for transmitting the at least one targeted offering to the user.

89.   (Previously presented)   The computer program as recited in claim 88 wherein the transmission of the matched offering to the user is done using a computer network.

90. (Previously presented) The computer program as recited in claim 89 wherein the network is the Internet.

91. (Previously presented) The computer program of claim 87 further comprising:

a module for using the user profile information as market intelligence.

92. (Previously presented) The computer program of claim 87 wherein the targeted offering is a financial instrument.

93. (Previously presented) A computer program as recited in claim 87 further comprising:

a module for notifying at least one provider of the suggested targeted offering when the user changes a preference related to attaining one or more of the goals.

94. (Previously presented) A computer program as recited in claim 87 wherein the offering includes at least one of a product and a service.

95. (Previously presented) A computer program as recited in claim 86 wherein the goals include at least one of a home, a vehicle, planned monthly allowance and savings, planned furniture expenses, planned appliance purchases, a vacation, children's education, and retirement home.

96. (Previously presented) A computer program as recited in claim 88 wherein the matched offering includes banner advertising displayed to the user, whereby the banner advertising content displayed is derived from the proposed goals designated by the user.

97. (Previously presented) A computer program as recited in claim 87 further comprising:

a module for storing the targeted offering in a database.

98. (Cancelled)

99. (Previously presented) A computer program as recited in claim 79 wherein each of the goals has a range of options, which can be further selected by the user, the computer program further comprising:

(a)   a module for displaying at least one provider for providing an option corresponding to a selected goal;

(b)   a module for allowing the user to select a preferred provider;

(c)   a module for allowing the user to select at least one option provided by the selected provider; and

(d)   a module for allowing the user to add the selected option to the range of options for the goal.

100. (Previously presented) The computer program of claim 99 wherein each option has a range of features, further comprising:

(a)   a module for displaying the range of options for a goal;

(b)   a module for allowing the user to select one of the options based on the adjusted preference;

(c)   a module for displaying at least one provider for providing an option corresponding to a selected goal;

(d)   a module for allowing the user to select the provider;

(e)   a module for allowing the user to select at least one option provided by the selected provider;

(f)   a module for allowing the user to select at least one feature provided by the selected provider for the selected option; and

(g)   a module for allowing the user to add the selected feature to the range of features corresponding to the selected option.

101. (Previously presented) A computer program as recited in claim 99 wherein a list containing a plurality of providers is displayed and the selected provider is selected from the list of providers.

102. (Previously presented) A computer program as recited in claim 99 wherein the at least one option includes a plurality of features, the method further comprising:

    (a)   a module for presenting to the user the plurality of features;

    (b)   a module for allowing the user to select at least one of the plurality of features for the selected option.

103. (Previously presented) A computer program as recited in claim 99 further comprising:

    a module for utilizing a network to display information relating to the provider.

104. (Cancelled)

105. (Previously presented) A computer program as recited in claim 99 further comprising:

    (a)   a module for presenting to the user at least one insurance provider;

    (b)   a module for allowing the user to select an insurance provider whose product can be employed to attain the goal.

106. (Previously presented) A computer program as recited in claim 99 further comprising:

    a module for displaying features of the selected option.

107. (Previously presented) A computer program as recited in claim 99 further comprising:

    (a)   a module for presenting to the user an indicia of desirability for the selected option; and

    (b)   a module for allowing the user to adjust the desirability for the selected option to reflect the user's desire for obtaining the selected option by adjusting the indicia of desirability.

108-122. (Cancelled)